



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,724	04/10/2001	John E. Jones	47171-00283	8425

30223 7590 03/31/2003

JENKENS & GILCHRIST, P.C.
225 WEST WASHINGTON
SUITE 2600
CHICAGO, IL 60606

[REDACTED] EXAMINER

NOWLIN, APRIL A

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

2876

DATE MAILED: 03/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/829,724	JONES, JOHN E. <i>[Signature]</i>	
	Examiner	Art Unit	
	April A. Nowlin	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-109 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4, 7, 8, 11-37, 40, 41 and 44-109 is/are rejected.
- 7) Claim(s) 5, 6, 9, 10, 38, 39, 42 and 43 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2,3</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 7, 8, 11, 12, 14-16, 21-32, 35-37, 40, 41, 44, 45, 47-49, 52-55, 57-63, 65-76, and 78-109 are rejected under 35 U.S.C. 102(e) as being anticipated by Pidhirny et al (US 6,473,519).

Re claims 1-4, 7, 8, 11, 15, 16, 21-24, 31, 32, 35-37, 40, 41, 44, 48, 49, 57, 61-63, 71, 75, 76, 78, 80, 87, 91, 92, 95, 96, 103, 104, and 108: Pidhirny et al discloses a check processing system comprising:

a document scanner 10 comprising a slot 18 adapted to accept a document, the scanner 10 acquiring at least one image therefrom, after having obtained an authorization agreement from a customer;

a communication link coupled to a central clearinghouse (i.e. host) and adapted to communicate information represented by the at least one image to the central clearinghouse for processing of the document;

wherein the authorization agreement is obtained verbally from the customer;

a printer for imprinting indicia of verbal authorization on the document;

means for imprinting the authorization agreement on a receipt;

a transport mechanism;

a controller coupled to the transport mechanism;

the scanner further adapted to compare a transaction amount printed on the document against a transaction amount keyed in by an operator;

whereby the document is a check;

at least one interface adapted to display information to an operator or the customer and adapted to receive a command from the operator or the customer;

a MICR reader 35 for reading a MICR data from the checks; and

a processor for obtaining information from the images of the check and storing the information in a memory. (See col. 1, line 56 to col. 2, line 67; col. 7, lines 39-58; col. 9, lines 60-67; col. 15, lines 1-65)

Re claims 12 and 45: Wherein the authorization agreement is displayed to the customer on a video screen (see col. 15, lines 27-37).

Re claims 14 and 47: The system further comprising a button on the video screen wherein the customer presses the button to execute the authorization agreement (see col. 15, lines 38-47).

Re claims 25, 66, 85, 97, and 105: Wherein the scanner further comprises a single scanhead (see col. 2, lines 34-43; col. 7, lines 59-62).

Re claims 26, 72, 88, 98, and 106: Wherein the scanner further comprises a multiple scanheads (see col. 2, lines 53-56; col. 8, lines 9-16).

Re claims 27, 67, 75, 86, 91, 107, and 108: Wherein the scanner further comprises a mirror for receiving an image of a first side of the document; a single scanhead for receiving the images from the mirror of the first side of the document; a transport mechanism for moving the document past the mirror and the single scanhead; and wherein the single scanhead receives an image of the second side of the document (col. 6, line 66 to col. 7, line 10).

Re claims 28, 52, 53, 74, 79, 90, 94, and 109: Wherein a plurality of documents are scanned and a plurality of images from the documents are transmitted in batches to the central clearinghouse (i.e. host). (See col. 11, lines 26-31)

Re claims 29 and 54: Wherein the document scanner transports and scans the document such that a longer edge of the document is perpendicular to the direction of transport (see col. 3, lines 47-50).

Re claims 30 and 55: Wherein the document scanner transports and scans the document such that a longer edge of the document is parallel to the direction of transport (see col. 3, lines 47-50).

Re claims 58, 68, and 81: Wherein the images obtained are full images of the checks (see col. 3, lines 1-3; col. 4, lines 21-25).

Re claims 59, 60, 69, 70, 82, and 83: Wherein the images obtained also include images of selected portions of the checks (see col. 3, lines 1-3).

Re claims 65 and 84: Wherein the plurality of scanners scan an endorsement side of the checks.

Re claims 73, 89, and 93: Wherein the scanners comprise a single acceptance and return slot.

Re claim 99: Wherein the processor comprises processing software, the software receiving image files from the processor and assembling reports in response thereto.

Re claims 100-102: Wherein the memory storage contains a customer database and wherein the database is accessible by customer name.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5, 6, 9, 10, 38, 39, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pidhirny et al (US 6,473,519). The teachings of Pidhirny et al have been discussed above.

Pidhirny et al fails to teach or fairly suggest wherein the imprinting means comprises a stamp for manually stamping the authorization agreement on the document. However, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ the notoriously old and well known stamp

to the teachings of Pidhirny et al in order to provide an alternative means of imprinting an authorization agreement to a document just in case the printer fails.

Allowable Subject Matter

5. Claims 13, 17-20, 33, 34, 46, 50, 51, 56, 64, and 77 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter: The prior art to Pidhirny et al teaches a check processing system, however the prior art of record, taken alone or in combination, fail to teach or fairly suggest a check processing system comprising an electronic signature pad and an electronic pen, the electronic signature pad adapted to receive a signature from the customer; and a printer adapted to inscribe the document with an indicia of cancellation.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Pat. No. 6,354,491 to Nichols et al

US Pat. No. 6,038,553 to Hyde, Jr.

US Pat. No. 6,283,366 to Hills et al

US Pat. No. 5,832,463 to Funk

US Pat. No. 5,940,844 to Cahill et al

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to April A. Nowlin whose telephone number is (703) 605-

1219. The examiner can normally be reached on Monday - Friday from 6:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7382 for After Final communications.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [april.nowlin@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

AAN
March 24, 2003


THIEN M. LE
PRIMARY EXAMINER